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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			CALLAHAN, PAUL E	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/507,478

Applicant(s)

MALVAR

Examiner

Paul Callahan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-11-2005 has been entered.

2. Claims 1-60 are pending in this application and have been examined.

### ***Response to Arguments***

3. Applicant's arguments filed have been fully considered but they are not persuasive.

The Applicant argues the amended claim 25 may be distinguished from Nicolai reference on the basis of an added limitation of a key being sent on a separate channel. Yet such is taught by the Hogan reference in col. 5 lines 32-34 in the rejection of the claims.

The Applicant argues that amended claim 52 may be distinguished from the prior art since Shepard fails to teach "processing the scrambled content to modify the scrambled content". Yet such was taught by Hogan in the abstract, fig. 7, and col. 5 lines 7-30.

The Applicant argues that error correction coding as taught by Hogan does not read on the claim language of "processing data". The Examiner continues to maintain that the term "processing data" as used by one of ordinary skill in the art does include error correction coding as a form of data processing.

The Applicant's attempt to distinguish between "processing tools" and a processor that is used to modify data is not clear. Any such "processing tools" will of necessity be implemented via a processor.

The Applicant asserts that the gating module (11) and tracking module (13) Nicolai cannot be a tone generator. yet col. 4 lines 22-34 do show such functionality. Nicolai teaches amplitude modulation at col. 5 lines 20-25.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 52 is rejected under 35 U.S.C. 102(e) as being anticipated by Shepard 5,598,164.

In the second box down on the right of figure 4, a provider (which reads on applicant's server) scrambles and then compresses a selection, which is content. This anticipates the first two clauses of claim 52. In the box below, the encrypted, compressed data is sent to a customer, who reads on applicant's client. Thus is the third clause anticipated. In lines 18-41 of column 2, Shepard describes decompressing data and returning the decompressed data to a storage device. The decompression clearly reads on applicant's fourth clause. Data transfer is a type of processing and thus reads on the fifth clause. The content is then descrambled and output, thereby anticipating the last three clauses of claim 52.

7. Claim 27 is rejected under 35 U.S.C. 102(b) as clearly anticipated by Nicolai et al. (4188580).( abstract.)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 5, 8, 10, 14, are rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over applicant's admitted prior art in view of Hogan (6047069).

As for claim 1, Figure 2 of applicant's disclosure, which is labeled as prior art, presents one of more output devices (element 44), a content player (element 52), and a processor (element 64). The operation of these elements requires a processor, a memory, and an operating system. As such, the limitations of the first five clauses of claim one are met. This prior art diagram does not say that data is scrambled before being processed, or that it is decrypted after the processing. In his abstract, figure 7, and lines 7-30 of column 5, Hogan teaches processing data while it is encrypted, thereby preventing access to confidential data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to keep data encrypted during its processing, as taught by Hogan, to protect data from illicit viewing. Hogan teaches the processing tools modifying the scrambled content in the abstract, fig. 7, and col. 5 lines 7-30.

As for Claim 2, the Claim is rendered obvious by applicant's background section which teaches filter graphs as being used in processing.

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As for Claims 5 and 8, the Claims are rendered obvious by lines 18-20 of column 2, which teach XoRing to effect scrambling. The same three lines teach that the added data be random.

Claim 10 is obvious because the random data block can be viewed as a key.

Claim 14 is obvious because of the structure of the admitted prior art.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art and Hogan as applied to claim 1 above, and further in view of Schneier Applied Cryptography.

Hogan, as applied to applicant's admitted prior art, teaches processing data while the data is encrypted in order to protect the data. Neither reference mentions receiving the data, in encrypted, compressed form, from an outside source. On page 226, Schneier gives reasons to both encrypt and compress data: the amount of data is reduced, security is increased, etc. The section also implicitly teaches transmission. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive encrypted, compressed data from an outside source, as taught by Schneier, and to decrypt and decompress that data at the media player in applicant's admitted prior art.

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11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art and Hogan as applied to claim 1 above, and further in view of Nyström et al. (6526091 ).

Hogan, as applied to applicant's admitted prior art, teaches processing data while the data is encrypted in order to protect the data. Neither reference mentions that the encryption adds a noise signal. In lines 15-18 of column 5, Nyström et al. show the addition of pseudo-random noise as a means to scramble data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the encryption in Hogan to add a noise signal, as taught by Nyström et al.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art and Hogan as applied to claim 1 above, and further in view of Bae (5991416).

Hogan, as applied to applicant's admitted prior art, teaches processing data while the data is encrypted in order to protect the data. Neither reference mentions time-domain or frequency-domain scrambling as the preferred method of scrambling. In lines 19-24 of column 1 , Bae teaches four scrambling techniques, two of which are time-domain and frequency-domain, used to obscure voice data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was



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made to use time-domain or frequency-domain scrambling in applicant's admitted prior art when the data is voice data, which is common in today's communications.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art and Hogan as applied to claim 1 above, and further in view of Marzahn (6526145).

Hogan, as applied to applicant's admitted prior art, teaches processing data while the data is encrypted in order to protect the data. According to the combination, encryption is performed by the content player. Neither reference mentions that a descrambler is resident on a driver for the output device. In lines 16-22 of column 1, Macahn teaches driver decryption as a way to implement a transparent encryption system. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement decryption in the output device driver as taught by Macahn in order to transparently protect the data.

14. Claims 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art and Hogan as applied to claim 1 above, and further in view of Nicolai et al. (4188580).

As for claims 9 and 11, Hogan, as applied to applicant's admitted prior art, teaches processing data while the data is encrypted in order to protect the data. Neither

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reference mentions uses a sync tone and random signal. In their abstract, Nicolai et al. describe embedding a first signal (tracking data) representing a first key into data, basing a second signal (pseudo-random signal) on the first signal and on a second key (pseudo-random number generator's inherent seed), and embedding the second signal in the data also. While Nicolai et al. explicitly only states that the second key is used to generate the pseudo-random signal, the tracking data is clearly used in the pseudo-random signal's regulation and hence creation. Nicolai et al.'s system prevents loss of synchronization. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ Nicolai et al.'s scrambling system in the combination of applicant's admitted prior art and Hogan.

As for claim 12, the claim is rendered obvious by Hogan where the channel on which the seed is sent to the two entities (or transmitted from one to the other) is at least temporally separate from the channel used for the scrambled content.

As for Claim 13 is rendered obvious by Hogan who, in lines 32-34 of column 5, teaches securely transmitting a random number generator's seed.

15. Claims 15-26, 29, 32-35, and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al. (4188580) in view of the Hogan US 6,047,069 and Microsoft Press Computer Dictionary 3rd ed.

As for claims 15, 19, 20, and 21, Figure 98 and elements 11 and 13 of figure 1 anticipate a tone generator and modulator that create a periodic set of tone patterns. As described in lines 22-30 of column 4, the tones, described by Nicolai et al. as a tracking or masking signal, provide a masking function and thus anticipate a first key.

As shown in figure 1, the outputs of elements 11 and 13 find their way to the pseudo-random number generator (element 10). The pseudo-random number generator anticipates applicant's random number generator. (Applicant uses the phrase "random number generator", which encompasses both pseudo-random number generators and truly random RNGs: the examiner believes the latter would be unworkable in applicant's invention.) The second key is sent by the code select (element 76).

As described in the abstract, the first key (as the tracking signal) and the pseudo-random generator output are added to the signal, thereby anticipating the third clause of claim 15. See also elements 33 and 36 in figure 1. Nicolai et al. do not say that the first key is embodied in the tracking signal as amplitude modulations. The definition of amplitude modulation in the computer dictionary defines it as encoding data in a constant frequency transmission by varying amplitude. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the first key of Nicolai et al. in the tracking signal by modulating the amplitude of the tracking signal, as is well known in the art of computer communications.

Nicolai does not explicitly teach sending a second key on a separate channel. Hogan does teach this feature in the abstract, fig. 7, and col. 5 lines 7-30. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to

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have incorporated this feature into the system of Nicolai. It would have been desirable to do so as this would significantly increase the security of key transmission.

As for Claim 18, Nicolai et al. and the dictionary present a system in which two keys are used to form a scrambling signal. One of the keys is included with the encrypted information. The second key is formed by code select. They do not say that the second key is encrypted for secure transportation to a descrambler. On page 176, Schneier teaches key-encryption keys, which encrypt other keys for distribution. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the second key in Nicolai et al. using a key-encrypting key, as taught by Schneier. Nicolai et al. need a second key to seed the code select.

As for claim 25, the claim contains limitation not explicitly taught by Nicolai of a second key being sent via a separate channel. Hogan does teach this feature in the abstract, fig. 7, and col. 5 lines 7-30. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Nicolai. It would have been desirable to do so as this would significantly increase the security of key transmission.

As for claim 16, Figure 98 and elements 11 and 13 of figure 1 anticipate a tone generator and modulator that create a periodic set of tone patterns. As described in

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lines 22-30 of column 4, the tones, described by Nicolai et al. as a tracking or masking signal, provide a masking function and thus anticipate a first key.

Claim 17 is rendered obvious because bit-value communications are anticipated by computer communications.

Claims 19 and 20 include the same limitations as claim 15 and are therefore rejected on the same basis as are those claims.

Claims 21-24 pertain to descrambling and are rendered obvious by the elements cited above.

As for claims 26 and 29, Nicolai et al. teach a system in which two keys are used to form a scrambling signal. One of the keys is included with the encrypted information. They do not say that the scrambling and descrambling are implemented within an operating system. The computer dictionary teaches operating systems as controlling resources. Implementing the functions in software, as opposed to hardware, would make the process accessible to computers that lack the hardware. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the system of Nicolai et al. in software such as an operating system.

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Claims 32-35 are rendered obvious for the same reasons as claims 15-17 and 21.

Claims 55-57 are the program product embodied in a memory medium causing the apparatus of claims 15 and 21 to carry out the method of the invention and are therefore rejected on the same basis as are those claims.

16. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al. in view of Hogan.

Nicolai et al. teach a system in which two keys are used to form a scrambling signal. One of the keys is included with the encrypted information. They do not say that the scrambling and descrambling both occur at the recipient. Hogan presents a system that scrambles content before it is processed and then descrambles the content after processing, thereby protecting the content during processing. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the scrambling and descrambling of Nicolai et al. at a receiver, thereby protecting the data during processing as taught by Hogan.

17. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al. in view of Macahn (6526145).

Nicolai et al. teach a system in which two keys are used to form a scrambling

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signal. One of the keys is included with the encrypted information. They do not say that a descrambler is resident on a driver for the output device. In lines 16-22 of column 1, Macahn teaches driver decryption as a way to implement a transparent encryption system. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement decryption in the output device driver as taught by Marzahn in order to transparently protect the data.

18. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al. in view of Schneier Applied Cryptography.

Nicolai et al. present a system in which two keys are used to form a scrambling signal. One of the keys is included with the encrypted information. The second key is formed by code select. They do not say that the second key is encrypted for secure transportation to a descrambler. On page 176, Schneier teaches key-encryption keys, which encrypt other keys for distribution. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the second key in Nicolai et al. using a key-encrypting key, as taught by Schneier. Nicolai et al. need a second key to seed the code select. Encrypted communications form a cryptographically secure path.

19. Claims 36, 39-41, 43, 44, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al. and Hogan as applied to claim 28 above, and further in view of Schneier. Nicolai et al. and Hogan teach encrypting data at a client,

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processing the encrypted data, and then decrypting and playing the data. They do not say that the data is encrypted and compressed for transmission from the server to the client. On page 226, Schneier gives reasons to both encrypt and compress data: the amount of data is reduced, security is increased, etc. The section also implicitly teaches transmission. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive encrypted, compressed data from an outside source, as taught by Schneier, and to decrypt and decompress that data at the media player in Nicolai et al. and Hogan. Hogan teaches the processing tools modifying the scrambled content in the abstract, fig. 7, and col. 5 lines 7-30.

20. Claims 37, 38, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al., Hogan, and Schneier as applied to claims 36 and 39 above, and further in view of applicant's admitted prior art and Macahn.

Nicolai et al., Schneier, and Hogan teach encrypting data at a client, processing the encrypted data, and then decrypting and playing the data. They do not say that the scrambler is implemented in the scrambler or that the descrambler is in the driver.

Applicant's admitted prior art puts the scrambler in the media player. Marzahn teaches driver decryption. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the scrambler to be embodied in the media player and for the driver to contain the descrambler. Operating systems controls the operations of a computer. Claim 47 is rendered obvious because applicant's admitted prior art teaches filter graphs.



22 . Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al., Hogan, and Schneier as applied to claim 39 above, and further in view of Bae. Nicolai et al., Schneier, and Hogan teach encrypting data at a client, processing the encrypted data, and then decrypting and playing the data. They do not say that time-domain or frequency-domain scrambling is the preferred method of scrambling. In lines 19-24 of column 1 , Bae teaches four scrambling techniques, two of which are time-domain and frequency-domain, used to obscure voice data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use time-domain or frequency-domain scrambling in Nicolai et al.

23. Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicolai et al., Hogan, and Schneier as applied to claim 39 above, and further in view of the Microsoft Press Computer Dictionary 3rd ed.

Nicolai et al., Schneier, and Hogan teach encrypting data at a client, processing the encrypted data, and then decrypting and playing the data.

They do not say that the first key is embodied in the tracking signal as amplitude modulations. The definition of amplitude modulation in the computer dictionary defines it as encoding data in a constant frequency transmission by varying amplitude. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the first key of Nicolai et al. in the tracking signal by

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modulating the amplitude of the tracking signal, as is well known in the art of computer communications.

24. Claims 53, 54, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shepard in view of Nicolai et al. and the Microsoft Press Computer Dictionary, 3<sup>rd</sup> ed.

Shepard presents a system that keeps digital data in encrypted form, only decrypting while changing the data to analog form. He does not specify how the encryption is implemented. Nicolai et al. and the computer dictionary (as described above) present a system that scrambles data by adding periodic tones modulated by a first key and a pseudo-random signal based on both the first key and a second key. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the scrambling system of Nicolai et al. with Shepard so that the encryption would be applicable to both analog and digital signals.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent document teaches features pertinent to the applicant's invention:

Chapman                      3,624,297

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

*Paul Callahan*